

REMARKS

Summary of the Office Action

Claims 1-6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,623,082 to Kurosawa (hereinafter "Kurosawa").

Claims 2-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurosawa.

Summary of the Response to the Office Action

Claims 1-6 have been amended. Claims 7-14 have been added. Accordingly, claims 1-14 are presently pending.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended claims 1-6 in accordance with the comments in the Office Action. Applicant respectfully submits that the amendments to claims 1-6 do not narrow the intended scope of the claim, and therefore, Applicant does not intend to relinquish any subject matter by these amendments. Applicant respectfully submits that claims 1-6, as amended, fully comply with the requirements of 35 U.S.C. § 112, second paragraph.

The Rejections Under 35 U.S.C. §§ 102 and 103

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Kurosawa.

Claims 2-6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurosawa.

Applicant respectfully traverses these rejections for at least the following reasons.

Applicant respectfully submits that Kurosawa does not teach at least the detection of “a position of the engaging plate...” or detecting the “**remaining amount** of the sheet-like staples...” (emphasis added) both required by amended claim 1.

Kurosawa discloses a photosensor which detects “whether the staple sheet 25 is present or absent in the cartridge 2...” (Col. 9, lines 51-54). In Kurosawa, the position detection means (photosensor PT2) detects whether the sheet-staples (25) are present or absent, it does not detect the position of the engaging plate (26). That is, Kurosawa does not teach or disclose “a position detecting mechanism...for detecting a position of the **engaging plate**,” (emphasis added) as recited in amended claim 1. Furthermore, Kurosawa only discloses detecting whether there are staples or there are no more staples left. (Col. 10, lines 9-11). In contrast, the present invention according to claim 1, as amended, is able to detect the “**remaining amount** of sheet-like staples...based on the detection of the position of the engaging plate....,” (emphasis added) not merely just whether there are any staples left.

As pointed out in MPEP § 2131, “[to] anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth

in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).”

Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn.

As pointed out in MPEP § 2143.03, “[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” Applicant respectfully submits that claim 4 as amended is in condition for allowance for reasons similar to those stated above with respect to independent claim 1. Accordingly, Applicant respectfully requests that the rejection of independent claim 4 under 35 U.S.C. § 103(a) be withdrawn. Furthermore, Applicant respectfully submits that dependent claims 2-3 and 5-6 are allowable at least because of their dependence on claims 1 and 4 respectively and the reasons set forth above.

In addition, Applicant traverses the “Official Notice” taken in the Office Action as to claims 2, 3, 5 and 6 and requests that documentary evidence be provided. As pointed out in MPEP § 2144.03(A), “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” (*citing In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). As to claims 2 and 5, as amended, Applicant respectfully submits that the applied art does not teach or suggest detecting the amount of sheet-like staples based on the position of the engaging plate

detected by a value of voltage measured across the output terminals in the position detecting mechanism, as claimed.

As to claims 3 and 6, as amended, Applicant respectfully submits that the applied art does not teach or disclose detecting the remaining amount of sheet-like staples by determining the position of the engaging plate based on the number of times of transmitting and cutting off light irradiated to the portion of transmitting and portion of reflecting light, respectively, as claimed. Pages 4 and 5 of the Office Action dated February 10, 2006 admit that Kurosawa does not disclose “cutting off light irradiated to the portion of transmitting and the portion of reflecting light, and the remaining amount of the sheet-like staple is detected based on the detection of the position.” Nonetheless, the Office Action asserts “Examiner Takes Official Notice that photosensor irradiating light and cutting off is well known in the art and would have been obvious to one skilled in the art for accurate detection of the staples.”

Applicant notes that the Office Action has provided no teaching or suggestion in the prior art that it would have been obvious to one of ordinary skill in the art to modify Kurosawa as mentioned above. Applicant submits that the features of claims 2, 3, 5 and 6, as amended, are not obvious to one of ordinary skill in the art. The MPEP instructs that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The MPEP further instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” MPEP

§ 2143.01. Applicant respectfully submits that the rejections of claims 2, 3, 5 and 6, as amended, is improper in view of MPEP § 2144.03 because it lacks evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill.

New Claims 7-14

Applicant respectfully submits that new claims 7-14 are allowable over the applied art. Specifically, the applied art does not teach or disclose having a “position detecting mechanism [that] provides an electrical signal based on the detection of the position of a projected portion of the engaging plate,” as recited in claims 7 and 10. Nor does it disclose “the position detecting mechanism detects at least three positions of the engaging plate...,” as recited in claims 13 and 14.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant’s undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: May 3, 2006

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